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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
0329-0008

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Application Number	Filed
09/787,172	06/12/2001

First Named Inventor
Ulrich Muller

Art Unit	Examiner
2624	Desire, Gregory

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 33,723

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Andrew G. Kolomayets
Typed or printed name

(312) 236-8500
Telephone number

August 10, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

PATENT
Attorney Docket No. (0329-0008)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Ulrich Müller, et al.

Serial No.: 09/787,172

Filed: June 12, 2001

Group Art No.: 2624

Examiner: Gregory Desire

For: SYSTEM FOR MEASURING THE SURFACE GEOMETRY AND SURFACE EVENNESS OF FLAT PRODUCTS

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PATENT
Attorney Docket No. 0329-0008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Ulrich Müller, et al.

Serial No.: 09/787,172

Filed: June 12, 2001

Examiner: Gregory M. Desire

Art Unit: 2625

For: SYSTEM FOR MEASURING THE SURFACE GEOMETRY AND SURFACE EVENNESS OF FLAT PRODUCTS

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Commissioner for Patents
P.O. Box 1450
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Reasons for Review of Final Rejection

Dear Examiner:

In support of the Notice of Appeal and Pre-Appeal Brief Request for Review filed herewith, Applicant is requesting review as set forth below:

Claims 14 – 27 are pending. Claims 14, 20, 21, and 23 are independent claims. In the Office Action of May 18, 2007 (hereinafter referred to as the "Office Action"):

Claims 14-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bullock et al (U.S. Patent No. 5,488,478) in view of Task et al (U.S. Patent No. 4,623,258).

Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bullock and Kuhn et al [sic][1] (U.S. Patent No. 5,592,246) (Page 4).

[1] Applicants believe that this may be a typographical error. On Page 3 of the final Office Action, mailed June 18, 2007, the Examiner stated that the rejections of claims 14-27 were in view of only Bullock and Task. Moreover, independent claim 14, upon which claim 15 depends, was rejected based on Bullock and Task, and not on Kuhn. In view of the rejection of claim 14, the combination of only Bullock and Kuhn would not have rendered dependent claim 15 obvious.

Claim 15 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Bullock et al and Task et al in further view of Gassler et al (U.S. Patent No. 5,339,154)

Applicant respectfully requests that the Office withdraw the rejections of claims 14-27 for the reasons set forth below.

The Rejection of Claims 14-27 Is Based on Improper Hindsight

In rejecting claims 14-27 under § 103(a), the Office Action must set forth the factual basis to support the legal conclusion of obviousness. In doing so, the Office cannot impermissibly use the instant claims as guide or roadmap in formulating the rejection. The Supreme Court recently stated that "[a] fact finder should be aware of course of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (U.S. 2007) *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966) (warning against a "temptation to read into the prior art the teachings of the invention in issue"). It is respectfully submitted that the Office Action improperly plucked the word "transparency" from Task without considering the context in which the term is used in both the claims and in Task.

The Office Action stated that the suggestion/motivation for combining Task with Bullock "would have been measuring haze index." (Page 4). The definition of "haze," as defined in Webster's Third New International Dictionary (Unabridged 2002), is "1b: a cloudy appearance in a transparent liquid or solid." According to Task, "haze" is the measured ratio of scattered light compared to the total light that passes through a transparency (such as an aircraft windscreen made of plastic) with a range from 0 (no scattering) to 1 (total scattering) (col. 1 lines 53-65, and lines 22-23).

"If the prior art is directed to a different purpose and different structures, other than the purpose addressed by the claimed invention, the inventor would have had less motivation or occasion to consider it." *In re Clay*, 966 F2d 656, 659 (Fed. Cir. 1992). Task is a clearly directed to a completely different purpose than what is addressed by the claimed invention. Specifically, Task is directed to measuring a property (haze or halation) of transparent material ("transparency").

Bullock does not measure "haze," the "haze index," or the "halation in transparencies such as aircraft windscreens" (Task, col. 1, line 22, halation is "sometimes called haze, veiling glare or contrast loss" see col. 8, lines 58-59). Nor does Bullock mention the word "haze."

Bullock provides a solution to problem a completely unrelated Task: measuring the **shape** of a surface, for example, of a metal strip. (col. 1, line 5-9). As recognized by the Examiner, the solution taught by Bullock is also different from the solution offered and claimed by the Applicant. While the Supreme Court stated in *KSR Int'l Co. v. Teleflex Inc.* that it may be permissible to use common sense to look beyond the particular being solved, the subject matter, respective purposes, and teachings of Task and Bullock are very far removed. *See KSR Int'l Co.*, 127 S. Ct. at 1740. One of ordinary skill in the art utilizing *common sense* at the time of the invention would not have reasonably looked to Task to solve the problem being addressed by Bullock. The teachings of Task are simply irrelevant, as Task involves measuring the haze of a transparency (col. 4, lines 45-50) and not measuring the shape of a surface. Thus, the only basis for combining Task and Bullock is the language of the Applicant's claims.

Accordingly, favorable reconsideration and withdrawal of the rejection of claims 14-27 under §103 are respectfully requested. In the event that the Office maintains this obviousness rejection, Applicant respectfully requests that the Office articulate, for the record and with specificity sufficient to support a *prima facie* case of obviousness, the factual basis on which it is alleged that the motivation/suggestion to combine Task with Bullock.

The Office Action Fails to Support a *Primia Facie* Case of Obviousness Based on the *Graham* Factors

In rejecting claims 14-27 under 35 U.S.C. § 103, the Office is required to establish a factual basis to support the legal conclusion of obviousness. In doing so, the Office Action must explicitly make the factual determinations set forth in *Graham v. John Deere Co.* 383 U.S. 1, 17 (1966). *See KSR Int'l Co.*, 127 S. Ct. at 1741 ("To facilitate review, this analysis should be made explicit."). The analysis under §103 is objective: "(1) the scope and content of the prior art are to be determined; (2) differences between the prior art and the claims at issue are to be ascertained; and (3) the level of ordinary skill in the pertinent art resolved." It is respectfully submitted that the legal conclusions offered by the Office Action are not supported by a fair reading of the prior art.

The Office Action asserted that claims 14-27 are within scope and content of the cited Bullock and Task references. It is respectfully submitted that the Office Action failed to appreciate the scope and content of the references and, in particular, the scope and content of the Task reference. The Office Action stated that: "Task discloses pattern produced to be measured

by projection with the aid of transparency (note fig. 1a, 14, transparency and col. 4 lines 45-50, Task teaches projection with transparency)." It is respectfully submitted that the Office Action has mischaracterized the content and teachings of Task.

Column 4, lines 45-50 of Task, cited by the Office Action in support of its contentions, shows "a system, generally designated 10, for carrying out the **haze measurement** method of the present invention, adapted for laboratory testing **of transparencies**." In fact, the item or thing measured by the method set forth in Task is the very transparency, such as an aircraft windscreens made of plastic or the like. (Col. 1, lines 22-23). The transparency of Task does not produce a pattern and does not "aid" in the projection as asserted by the Office Action. Task does not teach projection with transparency, it teaches a method of measurement of haze **in a transparency**. *See* col. 2 lines 43-45("Accordingly, the present invention broadly provides a method for measuring haze in transparency..."). The Office Action fails to reconcile the differences of Task with that of Bullock and the claimed invention.

Additionally, the difference between the claimed invention and the cited art are such that the cited references do not teach or suggest all of the claim limitations. Independent claim 14 calls for "providing a moving metal strip, a light source and a transparency between said light source and said metal strip surface." This relationship is not identified by the Office Action and is not taught or suggested by the cited references. Similarly, independent claims 20 and 23 recite: "providing a light source disposed above said moving metal strip," and "delivering said light through a transparency on to said metal surface." As stated above, Task teaches a method for measuring a property (haze) of a transparent material ("transparency"). The light source of Task does not project with the "aid" of a transparency, as asserted by the Office Action. Rather, **the light source is used to measure the haze of the transparency**. It is respectfully submitted, that the substitution of that which is being measured in Task (transparent material) for a component that is an integral part of the device in Bullock is unfounded and not supported by a fair reading of the references. Accordingly, favorable reconsideration and withdrawal of the rejections of independent claims 14, 20, 23 and their respective dependent 35 U.S.C. §103 are respectfully requested.

Finally, the Office Action made no attempt to resolve the level of skill of ordinary skill in the pertinent art. The Office Action concluded that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a light source which projects

with the aid of the transparency." The Office Action stated that the suggestion/motivation for doing so "would have been measuring haze index." As stated above, the claimed invention does not measure the haze index of transparencies, but rather the geometry and evenness of a metal surface.

In view of these fundamental differences between the subject matter of Bullock and the above-described subject matter of Task, Applicant submits that one of skill in the art would not have the ability to modify Bullock based on the completely unrelated teachings of Task to arrive at the claimed invention. In short, the claimed invention would not have been obvious to one skilled in the art at the time of invention.

Accordingly, favorable reconsideration and withdrawal of the rejection of claims 14-27 under §103 are respectfully requested. In the event that the Office maintains this obviousness rejection, Applicant respectfully requests that the Office articulate, with specificity sufficient to support a *prima facie* case of obviousness, the level of ordinary skill and as to why one having that level of skill in the art would modify the system of Bullock with the "transparency" (i.e. aircraft windscreens, *see* col.1, line 22) of Task to arrive at the claimed invention, which does not measure a "haze index." *See KSR Int'l Co.*, 127 S. Ct. at 1741 (it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.").

Reconsideration and allowance of claims 14-27 are respectfully requested.

Respectfully submitted,

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